

ADMINISTRATIVE PANEL DECISION

Kohler Co. v. xiaodie Wu

Case No. D2022-1910

1. The Parties

The Complainant is Kohler Co., United States of America (“United States”), represented by Taft Stettinius & Hollister LLP, United States.

The Respondent is xiaodie Wu, China.

2. The Domain Name and Registrar

The disputed domain name <kohler-shop.com> (the “Domain Name”) is registered with DropCatch.com LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 12, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 31, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 23, 2022.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on June 28, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant was founded in 1873 and *inter alia* designs, manufactures, and sells a wide range of kitchen and bathroom products, with affiliates and sales offices across the world.

The Complainant holds, *inter alia*, the following trade mark registrations (the “Trade Marks”):

- United States word mark KOHLER, registered under No. 94999 on January 20, 1914;
- United States word mark KOHLER, registered under No. 3352028 on December 11, 2007; and
- China word mark KOHLER, registered under No. 26191304 on August 21, 2018.

The Domain Name was registered in the name of the Respondent on September 23, 2021. Evidence from the WayBack Machine (<internetarchive.org>), consulted by the Panel on July 5, 2022, shows that between 2014 and August 2019, under one or more previous domain name owners, the Domain Name resolved to a website on which bathroom and kitchen products were offered for sale, both in the English and Chinese language. When the Panel checked the website under the Domain Name on July 5, 2022 it was found to redirect to the domain name <j9cn08.com> which resolved to a website in the Chinese language offering betting services.

5. Parties’ Contentions

A. Complainant

According to the Complainant, the Domain Name is confusingly similar to the Trade Marks because it fully incorporates the Trade Marks, adding only the generic term “shop”, while the suffix “.com” is non-distinctive because it is required for the registration of the Domain Name. Moreover, the Complainant contends, the inclusion of the term “shop” in combination with the Trade Marks in the Domain Name makes confusion more likely by incorrectly suggesting some acquiescence, association, affiliation, or other connection with the Complainant.

The Complainant submits that the Respondent lacks rights or legitimate interests in the Domain Name and is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the Domain Name. The Complainant states that the Respondent refers to itself in the Whois database as xiaodie Wu, has never been commonly known by the Trade Marks nor any variations thereof, and has never used any trade mark or service mark similar to the Domain Name by which it may have come to be known, other than the use noted in the Complaint. The Complainant adds that it has not granted the Respondent any license, permission, or authorization by which it could own or use any domain name registrations, which are confusingly similar to any of the Trade Marks. Moreover, the Complainant brings forward that the Respondent has never operated any *bona fide* or legitimate business under the Domain Name, and is not making a noncommercial or fair use of the Domain Name.

According to the Complainant, there is no reason for the Respondent to have registered the Domain Name other than to trade off the reputation and goodwill of the Trade Marks and to disrupt the Complainant’s business. The Complainant contends that the makeup of the Domain Name itself and the nature of use evidences bad faith registration and use as there can be no other conclusion than the Domain Name was registered and is being used with actual knowledge of the Complainant and its Trade Marks. The Complainant also points out that if the Respondent had conducted a preliminary trade mark search or even a simple browser search, it would have found the Trade Marks, the Complainant’s websites associated with the Trade Marks, and numerous additional references in commerce, on the Internet, and in publications, evidencing the Complainant’s use of the Trade Marks in connection with its goods and services. Furthermore, the Complainant submits, the Respondent used the Domain Name to capitalize on Internet

users' efforts to find the Complainant's website by using the Trade Marks in the Domain Name, which constitutes bad faith registration and use in accordance with paragraph 4(b)(iv) of the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates KOHLER, of which the Trade Marks consist, in its entirety. The addition of the term "shop" does not prevent a finding of confusing similarity between the Domain Name and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The generic Top-Level Domain ".com" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11). Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the second element a complainant has to prove is that a respondent lacks rights or legitimate interests in a domain name. This may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Name. If the Complainant succeeds in doing so, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element (see [WIPO Overview 3.0](#), section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has no connection or affiliation with the Complainant, the Respondent has not received the Complainant's consent to use the Trade Marks as part of the Domain Name, and the Respondent has not acquired any trade mark rights in the Domain Name. In assessing whether the Respondent has rights or legitimate interests in the Domain Name, it should also be taken into account that (i) since the Domain Name incorporates the Trade Marks in their entirety with a descriptive term, it carries a risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1); and (ii) the Respondent has not provided any evidence, nor is there any indication in the record of this case, that the Respondent is commonly known by the Domain Name. Furthermore, in view of the fact that the Domain Name redirects to the domain name <j9cn08.com> which resolves to a website providing gambling services, the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, nor does such use constitute a *bona fide* offering of goods or services.

In view of all of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Based on the undisputed information and the evidence provided by the Complainant, the Panel finds that there is bad faith registration. At the time of registration of the Domain Name, the Respondent was or should have been aware of the Complainant and the Trade Marks, since:

- the Respondent's registration of the Domain Name occurred some 107 years after the registration of the earliest of the Trade Marks;
- the Respondent has incorporated KOHLER, of which the Trade Marks consist, in their entirety, and this is not a generic term, nor a name that it is likely that a registrant would spontaneously think of when registering a domain name;
- a simple trade mark register search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks; and

With regard to bad faith use, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the Domain Name:

- the probability that the Respondent was aware or should have been aware of the Complainant's rights in the Trade Marks;
- the lack of a Response to the Complaint; and
- the use of the website to which the Domain Name is redirected for gambling services.

Therefore, the Panel concludes on the basis of all of the above circumstances, taken together, that the Domain Name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <kohler-shop.com> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: July 7, 2022